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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,065	11/12/2003	Michael Sittinger	27600/X014A	6362

29471 7590 04/02/2007  
MCCRACKEN & FRANK LLP  
200 W. ADAMS STREET  
SUITE 2150  
CHICAGO, IL 60606

EXAMINER
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NICHOLSON III, LESLIE AUGUST

ART UNIT	PAPER NUMBER
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3651

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/706,065

**Applicant(s)**

SITTINGER ET AL.

**Examiner**

Leslie A. Nicholson III

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. All previous 35 USC 112 1<sup>st</sup> and 2<sup>nd</sup> paragraph rejections are withdrawn.

Applicant's arguments with respect to the rejection(s) of claim(s) 1-54 under prior art references have been fully considered and but are not persuasive. Applicant argues Warmus (USP 6327599) "does not teach coordinating the simultaneous operation of a gathering line, a demand printer that is capable of printing without limitation as to position and orientation of customized content over an entire surface of a page, and a feeding device during a production sequence". In response, a combination of the cited references, as shown in the Action filed 12/18/2006, would have resulted in the claimed invention, as obvious to one having ordinary skill in the art. Applicant further argues that a combination of any of Graushar, Dooley, or Weller with Warmus ('599) would have successfully resulted in a gathering line, a demand printer that is capable of printing without limitation as to position and orientation of customized content over an entire surface of a page, and a feeding device all operable during a single production sequence. In response, the references are all within the same field of endeavor, and it is obvious to one having ordinary skill in the art, that the combination of the references, as shown in the Action filed 12/18/2006, would have resulted in the claimed invention. Furthermore, Applicant has not provided evidence as to why the combinations would not be obvious to one having ordinary skill in the art. All prior art rejections are maintained.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,2,8,9,13,23,24,30,31,35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599.

Dooley discloses a book production device that includes a gathering line (14); a demand printer (56); a feeding device (58); a packer box (16) with a transfer mechanism (see col. 4, line 3); and a controller (60). Dooley does not expressly disclose means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over

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an entire surface of the page, as taught by Warmus, in the device of Dooley, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

4. Claims 1,2,12-16,20,22-24,35-38,43-45,49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar USP 5,100,116 in view of Warmus USP 6,327,599.

Graushar discloses a book production device that includes a gathering line (18); a plurality of demand printers (32, see col. 4, line 51); a feeding device (33); and a controller (31). Graushar does not expressly disclose means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page, as taught by Warmus, in the device (or method) of

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Graushar, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

5. Claims 1,2,6,7,12-18,20,22-24,28,29,35-38,41,43-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weller USP 4,989,850 in view of Warmus USP 6,327,599.

Weller discloses a book production apparatus that includes a gathering line (90); a plurality of demand printers (75, see col. 5, lines 1-6); a feeding device (GR); a folding device (see col. 4, line 56); and a controller (see col. 3, line 56). Weller does not expressly disclose means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page, as taught by Warmus, in the device (or method) of Weller,

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for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

6. Claims 3-5,25-27,39,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar USP 5,100,116 in view of Warmus USP 6,327,599 further in view of Warmus USP 5,963,968.

Graushar discloses all the limitations of the claims, but it does not disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file.

However, Warmus ('968) discloses a book production device that includes disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file for the purpose of producing differing book versions in an efficient manner (see col. 3, lines 8-10).

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Graushar by utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file, as disclosed by Warmus ('968), for the purpose of producing differing book versions in an efficient manner.

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7. Claims 10,11,14,17,19,32,33,34 rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599 further in view of Weller USP 4,989,850.

Dooley discloses all the limitations of the claims, but it does not disclose a folder and it does not disclose a plurality of demand printers.

However, Weller discloses a book production device that includes a folder for the purpose of processing signatures which have not been folded (see col. 3, lines 4-6) and Weller discloses utilizing a plurality of demand printers for the purpose of customizing more than one page.

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a folder and a plurality of demand printers, as disclosed by Weller, for the purpose of processing signatures which have not been folded and customizing more than one page.

8. Claims 14,21,36,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599 further in view of Graushar USP 5,100,116.

Dooley discloses all the limitations of the claims, but it does not disclose a plurality of demand printers.

However, Graushar discloses a book production device that includes a plurality of demand printers for the purpose of customizing more than one page.



It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a plurality of demand printers, as disclosed by Graushar, for the purpose of customizing more than one page.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

L.N.  
3/28/2007

  
GENE C. CRAWFORD  
SUPERVISORY PATENT EXAMINER